

REMARKS

Reconsideration and allowance of the subject application are respectfully requested. Claims 5-13, 15, and 17 remain pending. In this Reply, Applicant has canceled claims 1-4, 14, and 16 without prejudice or disclaimer. Claims 5-12 have been rewritten as independent claims.

Claim Objections

As set forth on page 1 of the Office Action, claims 2 and 3 have been objected to based on certain informalities. Applicant submits that the cancellation of claims 2 and 3 has rendered these objections moot and requests that the objections be withdrawn.

Prior Art Rejections

1. Catanzaro

Claims 13, 15, and 17 stand rejected under 35 U.S.C. § 102 as allegedly being anticipated by Catanzaro et al. (U.S. Patent 5,502,727). This rejection is respectfully traversed.

Claim 13 is directed to an image communication system in which an image processing apparatus and a portable phone can communicate data with each other and in which the portable phone sets a print mode to produce a printout of an image by a printer. In the image communication system of claim 13, the image processing apparatus includes an image data converting device for converting, when the print mode is set by the portable phone, image data into data suitable for an output format of the printer and a first

transmitting device for transmitting, to the portable phone, the image data converted by the image data converting device. The portable phone includes: receiving means for receiving the image data transmitted from the first transmitting device of the image processing apparatus; and a second transmitting device for transmitting via the telephone line the image data received by the receiving device.

In rejecting claim 13, the Examiner cites col. 2, line 65 - col. 3, line 5 of *Catanzaro* as allegedly teaching the image data converting device recited in claim 13, which converts, when the print mode is set by the portable phone, image data into data suitable for an output format of the printer. The cited portion of the reference, however, merely indicates that various devices, including a printer, may be connected to the "enhanced phone" disclosed therein. *Catanzaro* fails to show or suggest that the image processing apparatus therein (identified as element 106 in Fig. 1) converts the image data into a printable format. Furthermore, there is no evidence of record indicating that such a feature would be inherent in the enhanced phone system disclosed by *Catanzaro*. If this grounds of rejection is maintained, Applicant respectfully requests that the Examiner provide objective evidence to support any assertions of inherency. See MPEP § 2112.

According to MPEP § 2131, "a claim is anticipated only if each and every element as set forth in the claim is found, either

expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claims." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913 (Fed. Cir. 1989).

At least in view of the above, Applicant respectfully submits that the asserted grounds of rejection fails to establish anticipation of claim 13. The asserted grounds of rejection fails to establish anticipation of claims 15 or claim 17 based on similar reasoning.

In view of the above, Applicant respectfully requests reconsideration and withdrawal of the rejection under 35 U.S.C. § 102.

2. Fukuoka - Sacca

Claims 1-6, 8, 9, 14, and 16 stand rejected under 35 U.S.C. § 103 as allegedly being unpatentable over *Fukuoka* (U.S. Patent 6,104,430) in view of *Sacca* (U.S. Patent 6,380,967). This rejection, insofar as it pertains to the presently pending claims, is respectfully traversed.

Initially, because claims 1-4, 14, and 16 have been canceled without prejudice or disclaimer, the following comments relate only to the Examiner's rejection of claims 5, 6, 8, and 9.

Claim 5

Claim 5 (like claims 6, 8, and 9) is directed to an image communication system in which an image processing apparatus and a first portable phone can communicate data with each other and in which the first portable phone can communicate with the second portable phone via a telephone line and in which the first portable phone sends an image data reduction instruction to the image processing apparatus. The image processing apparatus includes: an instruction receiving device for receiving the image data reduction instruction sent from the first portable phone; a data quantity reducing device for reducing a data quantity of image data according to the image data reduction instruction received by the instruction receiving device; and a first image data transmitting device for transmitting, to the first portable phone, the image data of which the data quantity is reduced by the data quantity reducing device. The first portable phone includes: an image data receiving device for receiving the image data sent from the first image data transmitting device of the image processing apparatus; and a second image data transmitting device for transmitting via the telephone line the image data received by the image data receiving device.

In claim 5, the first portable phone includes: a reduction ratio receiving device for receiving data representing a reduction

ratio sent from the second portable phone via the telephone line, and a reduction ratio transmitting device for transmitting, to the image processing apparatus, the reduction ratio data receive by the reduction ratio receiving device. In claim 5, the image processing apparatus further includes a reduction ratio data receiving device for receiving the reduction ratio data transmitted from the reduction ratio transmitting device of the first portable phone; and the data quantity reducing device reduces image data according to a reduction ratio associated with the reduction ratio data received by the reduction ratio data receiving device.

In rejecting claim 5, the Examiner cites col. 10, line 65 - col. 11, line 18 of the secondary reference, *Sacca*, as allegedly teaching the claimed reduction ratio receiving device and reduction ratio transmitting device features. Applicant notes, however, that the cited portions of *Sacca* merely disclose that a video fax 100 automatically grabs an image from video camera 102, and sends it at low or high resolution so that the user can select between low and high resolutions. Accordingly, the cited secondary reference fails to disclose or suggest the above-detailed claim features relating to reduction ratio data.

At least for this reason, the asserted combination of *Fukuoka* and *Sacca* (assuming these references may be combined, which Applicant does not admit) fails to establish *prima facie* obviousness of claim 5.

Claim 6

In the image communication system of claim 6, at least one of the first portable phone and the image processing apparatus includes detecting means for detecting a data communication speed on the telephone line, and the data quantity reducing device of the image processing apparatus increases a quantity of data reduction when a slower communication speed is detected by the detecting means.

In rejecting claim 6, the Examiner cites Fig. 15 and col. 12, lines 40-48 of *Fukuoka* as allegedly teaching these features. This cited portion of *Fukuoka* states that:

Depending upon the communication capabilities such as bandwidth of the type of I/O card, the CPU selects operating parameters of the camera in order to make the best use of the available I/O capabilities. The parameters which can be set based on the capabilities of the I/O card are described in the flowchart of FIG. 15.

Thus, in *Fukuoka*, the CPU selects operating parameters of the camera based on the communication capabilities such as bandwidth of the type of I/O card being used. There is no teaching in *Fukuoka*, however, that the operating parameters of the camera are based upon communication speed of a telephone line or that a quantity of data reduction is increased when the telephone line has a slower communication speed.

At least for this reason, the asserted combination of *Fukuoka* and *Sacca* fails to establish *prima facie* obviousness of claim 6.

Claim 8

In the image communication system of claim 8, the image processing apparatus further includes an image data recording device for compressing image data received and for recording the image data compressed on a recording medium and the image data quantity reducing device reduces the data quantity of image data by compressing the image data according to a compression ratio higher than a compression ratio used to compress data in the recording of the data on the recording medium.

In rejecting claim 8, the Examiner cites col. 5, lines 48-57 and col. 12, lines 40-42 of *Fukuoka* as allegedly teaching these features. Even if it can be concluded, however, that *Fukuoka* discloses that the image data compression/expansion circuit 12 compresses image data based on bandwidth limitations, the compression ratio therein would be determined based upon bandwidth limitations of the I/O card itself, not based on a compression ratio used to compress data in the recording of data on a recording medium as recited in claim 8.

At least for this reason, Applicant respectfully submits that the asserted combination of *Fukuoka* and *Sacca* fails to establish *prima facie* obviousness of claim 8.

Claim 9

In the image communication system of claim 9, the image processing apparatus further includes an image data recording device for compressing image data received and for recording the image data compressed on a recording medium and the image data quantity reducing device compresses data in a method different from a data compression method employed in the recording of the image data on the recording medium.

Therefore, according to claim 9, the image data is compressed by two different compression methods. One form of compressed image data is created by the image data quantity reducing device and the other form of compressed image data is created by the image data recording device. Thus, two types of compressed image data are created from the image data.

In rejecting claim 9, the Examiner cites Fig. 6, element 12, and col. 5, lines 48-57 of *Fukuoka* as allegedly teaching this feature. Applicant submits, however, that *Fukuoka* fails to teach or suggest two devices that create compressed image data of two types as claimed.

At least for this reason, Applicant respectfully submits that the asserted combination of *Fukuoka* and *Sacca* fails to establish *prima facie* obviousness of claim 9.

In view of the above, Applicant respectfully requests reconsideration and withdrawal of the Examiner's rejection under 35 U.S.C. § 103 based on the asserted combination of *Fukuoka* and *Sacca*.

3. *Fukuoka - Sacca - Catanzaro*

Claims 7, 11, and 12 stand rejected under 35 U.S.C. § 103 as allegedly being unpatentable over *Fukuoka* in view of *Sacca*, and further in view of *Catanzaro*. This rejection is respectfully traversed.

Claim 7

In the image communication system of claim 7, the first portable phone includes a mode notifying device for notifying modes available in the first portable phone, the modes including an image data transmission mode, and the first portable phone transmits, when the image data transmission mode is selected from the modes notified by the mode notifying device, the image data reduction instruction to the image processing apparatus.

In rejecting claim 7, the Examiner cites col. 6, lines 59-63 and col. 8, lines 41-49 of *Catanzaro* as allegedly teaching these claimed features.

Catanzaro, however, fails to show a first portable phone that transmits the image data instruction to the image processing apparatus when the image data transmission mode is selected.

At least for this reason, the asserted combination of *Fukuoka*, *Sacca*, and *Catanzaro* (assuming these references may be combined, which Applicant does not admit) fails to establish *prima facie* obviousness of claim 7.

Claim 11

In the image communication system of claim 11, the first portable phone further includes a device for transmitting a transmission instruction of image data for printout to the image processing apparatus. Claim 11 also recites that the image processing apparatus further includes: a device for receiving the print image data transmission instruction transmitted from the first portable phone; and control means for terminating the data quantity reduction processing by the image data quantity reducing device in response to reception of the print image data transmission instruction and for transmitting the image data before the data quantity reduction processing to the first portable phone.

In rejecting claim 11, the Examiner cites col. 3, lines 57-59 and col. 5, lines 36-38 of *Fukuoka* as allegedly teaching the "control means" of claim 11. Applicant submits, however, that *Fukuoka* fails to disclose or suggest the control function of

terminating the data quantity reduction processing in response to reception of the print image data transmission instruction as claimed. At least for this reason, the asserted combination of *Fukuoka*, *Sacca*, and *Catanzaro* fails to establish *prima facie* obviousness of claim 11.

Claim 12

In the image communication system according to claim 12, the first portable phone further includes a print mode setting device for setting a print mode in which a printer produces printout of an image, and the image processing apparatus further includes an image data converting device for converting, when a print mode is set by the first portable phone, the image data to be transmitted to the first portable phone into data suitable for an output format of the printer.

In rejecting claim 12, the Examiner cites Fig. 3, element 15 of *Fukuoka* and Fig. 1 of *Catanzaro* as allegedly teaching the data converting device feature recited in claim 12. Element 15 of *Fukuoka*, however, is an I/O card that does not convert image data when a print mode is set by a first portable phone. Furthermore, *Catanzaro* fails to teach or suggest the image processing apparatus converting the image data into data suitable for an output format of the printer as claimed. At least for this reason, the asserted

combination of *Fukuoka*, *Sacca*, and *Catanzaro* fails to establish *prima facie* obviousness of claim 12.

4. *Fukuoka - Sacca - Shiohara*

Claim 10 stands rejected under 35 U.S.C. § 103 as allegedly being unpatentable over *Fukuoka* in view of *Sacca*, and further in view of *Shiohara* (U.S. Patent 6,618,553). This rejection is respectfully traversed.

In the image communication system of claim 10, the image data of which the data quantity is to be reduced is associated with thumbnail data, and the first image transmitting device of the image processing apparatus transmits the thumbnail image data when the data quantity of the image data after the reduction of image data by the data quantity reducing means is in the vicinity of a data quantity of the thumbnail image data.

In rejecting claim 10, the Examiner cites col. 3, lines 1-23 and col. 7, lines 49-56 of *Shiohara* as allegedly teaching these features. Applicant submits, however, that *Shiohara* merely discloses that a digital camera is provided with a display device for displaying the thumbnail image and a printer for printing the thumbnail image, but fails to judge whether the data quantity of the image data after reduction is in the vicinity of a data quantity of the thumbnail image data as claimed.

At least for this reason, the asserted combination of *Fukuoka*, *Sacca*, and *Shiohara* (assuming these references may be combined, which Applicant does not admit) fails to establish *prima facie* obviousness of claim 10.

In view of the above, Applicant respectfully requests reconsideration and withdrawal of the Examiner's rejection under 35 U.S.C. § 103 based on the asserted combination of *Fukuoka*, *Sacca*, and *Shiohara*.

Conclusion

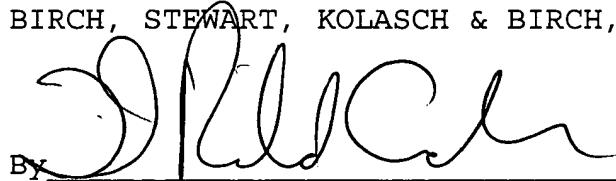
Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned at the telephone number below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Applicant respectfully petitions for a two (2) month extension of time pursuant to 37 C.F.R. §§ 1.17 and 1.136(a). A check in the amount of \$420.00 in payment of the extension of time fee is attached.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

A handwritten signature in black ink, appearing to read 'D. Anderson', written over a horizontal line.

By _____
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